

**REMARKS**

Claims 1-6, 11-16, 21, and 23-27 are pending and at issue.

**35 U.S.C. § 103 Rejections**

The applicants respectfully traverse the rejection of claims 1-6, 11-16, 21, and 23-27 as obvious over U.S. Design Patent No. D360,778 to Apt III et al. (“Apt”) in view of one or more of U.S. Design Patent Nos. D379,122 and D388,957 to Wolf (collectively “Wolf”) and U.S. Patent No. 5,125,697 to Kahl et al. (“Kahl”), collectively the “cited art.” To establish a *prima facie* case of obviousness, “all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981 (CCPA 1974), and M.P.E.P. § 2143.03.

**Independent claims 13 and 25**

Each of independent claims 13 and 25 recite a storage container comprising, in part, a first opening into a storage frame interior and a second opening into the storage frame interior. The cited art fails to disclose or suggest a storage container having more than one opening. The applicants respectfully disagree with the allegation in the Office action that Apt discloses a removable lid. *See* the official action ,page 2. It is not readily apparent to the applicants that Apt discloses a lid of any sort. None of the drawings of Apt disclose or suggest a removable lid. Further, none of the descriptions of the drawings include any suggestion that the container includes a lid of any sort, let alone a removable lid. Moreover, the title of Apt is “storage drawer,” not “storage drawer and lid,” or any similar title. Thus, the Office action appears to be impermissibly reading features into Apt that do not exist.

Wolf and Kahl also fail to disclose or suggest a storage frame having first and second openings. Rather, both Wolf and Kahl disclose a container having a single opening at a top portion of the container. *See* Wolf, Fig. 1 and Kahl, Fig. 1. As a result, none of Apt, Wolf and Kahl discloses or suggests a storage container including more than one opening. Thus, the applicants respectfully request withdrawal of the rejection of independent claims 13 and 25 and any claims depending therefrom as obvious over Apt, Wolf and Kahl.

**Independent claim 1**

Independent claim 1 recites a storage container comprising, in part, an opening in a top end of a storage frame and a drawer movably mounted within the storage frame. As

discussed above, with respect to independent claims 13 and 25, Apt fails to disclose or suggest a lid of any sort, thus, Apt fails to disclose or suggest an opening at a top end of a storage frame. Moreover, Apt fails to disclose or suggest more than one opening in the storage frame.

Similarly, both Wolf and Kahl only disclose one opening in the storage frame. Both Wolf and Kahl disclose a storage container including a lid and an opening in the top of the storage container. Wolf and Kahl fail to disclose or suggest a drawer or a second opening in the storage frame. As a result, Apt, Wolf and Kahl each fail to disclose or suggest both an opening in the top of the storage frame and a drawer movably mounted within the storage frame. Thus, the applicants respectfully request withdrawal of the rejection of independent claim 1 and any claims depending therefrom over Apt, Wolf and Kahl.

An advantage of providing multiple openings in the storage frame, as recited by the pending claims, is that a user has multiple access points into the storage area of the container. For example, should the container be surrounded by other containers rendering the drawer inaccessible, a user may simply use the top opening and lid to access the storage space within the container. Likewise, should other containers be stacked upon the storage container rendering the lid inaccessible, a user may simply use the drawer to access the storage space within the container. The cited art fails to even recognize this problem let alone suggest modifications that would enable a user to access the storage space through multiple openings in a storage container.

#### **No Motivation to Combine the References**

The applicants respectfully submit that there is no motivation to modify Apt as suggested in the official action because such a modification would render the Apt device unsatisfactory for its intended purpose. “If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984), and M.P.E.P. § 2143.01(V). Apt is a design patent and, as such, protects the “ornamental design” of a storage drawer. Modifying Apt to include a “container lid including a pivot extending from a side portion of the lid,” as suggested in the official action, would destroy the ornamental appearance of the Apt device. For at least this reason, there is

no motivation to modify the Apt device as suggested in the official action and the rejection of claims 1-6, 11-16, 21, and 23-27 in any part over Apt is improper and should be withdrawn.

Similar reasoning would result in there being no motivation to modify either of the Wolf devices.

### **Conclusion**

For the foregoing reasons, the applicants respectfully request reconsideration and allowance of all pending claims.

No fees are believed due. However, the Director is hereby authorized to charge any fees which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 13-2855, under Order No. 29618/39225B. A duplicate copy of this paper is enclosed.

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Respectfully submitted,

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